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Jack A. Zeineh

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EXAMINER

SMITH, CAROLYN L

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/620,016	Applicant(s) ZEINEH ET AL.	
	Examiner Carolyn L. Smith	Art Unit 1631	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 36-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 36-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>05272008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's amendments and remarks, filed 6/11/08, are acknowledged. Cancelled claims 1-35, amended claims 36-39 and 42, and new claim 44 are acknowledged.

Applicant's arguments, filed 6/11/08, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from the previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

Claims 36-44 are herein under examination.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 5/27/08 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement has been considered by the examiner.

Claim Rejections - 35 USC § 112, first paragraph

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 36-44 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant

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art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This rejection is necessitated by amendment.

NEW MATTER

Applicant did not point to any sections in the originally filed application that provide written support for the amended limitations. There does not appear to be adequate written support for "determination if said desired objective corresponds to a magnification of one of said one or more previously-captured images; and wherein if said desired objective corresponds to a magnification of one of said one or more previously-captured images, displaying said one of said one or more previously-captured images on a screen, and wherein if said desired objective does not correspond to a magnification of one of said one or more previously-captured images, obtaining a real-time image of microscope slide at said desired magnification and presenting said real-time image on said screen" (as stated in instant claim 36) and "determining if said desired magnification corresponds to a magnification of one of said one or more previously-captured images; and wherein if said desired magnification corresponds to a magnification of one of said one or more previously-captured images, displaying said one of said one or more previously-captured images on a screen, and wherein if said desired magnification does not correspond to a magnification of one of said one or more previously-captured images, obtaining and presenting a real-time image of microscope slide at said desired magnification on said screen" (as stated in instant claim 44). While the 7-page specification recites that optical objectives are images that are created by a camera digitizing an image through a microscope objective in real time, this does not provide adequate written support for the limitations above which differ in scope. There

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is no discussion in the originally filed application regarding determination if a desired objective corresponds to a magnification of one or more previously-captured images.

Because the introduction of “determination if said desired objective corresponds to a magnification of one of said one or more previously-captured images; and wherein if said desired objective corresponds to a magnification of one of said one or more previously-captured images, displaying said one of said one or more previously-captured images on a screen, and wherein if said desired objective does not correspond to a magnification of one of said one or more previously-captured images, obtaining a real-time image of microscope slide at said desired magnification and presenting said real-time image on said screen” (as stated in instant claim 36) and “determining if said desired magnification corresponds to a magnification of one of said one or more previously-captured images; and wherein if said desired magnification corresponds to a magnification of one of said one or more previously-captured images, displaying said one of said one or more previously-captured images on a screen, and wherein if said desired magnification does not correspond to a magnification of one of said one or more previously-captured images, obtaining and presenting a real-time image of microscope slide at said desired magnification on said screen” (as stated in instant claim 44) does not appear to have adequate written support in the specification, claim, and/or drawings, as originally filed, these limitations are considered to be NEW MATTER. Claims 37-43 are also rejected due to their dependency from claim 36.

Claim Rejections - 35 USC § 112, Second paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 37-43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These rejections are necessitated by amendment.

Claims 37, 38, and 42 recite the limitation "said previously-captured image" in lines 1-2 of each. There is insufficient antecedent basis for this limitation in the claim. While there is previous mention of "one or more previously-captured images", it is unclear to which particular image Applicant is referring to in "said previously-captured image". It is unclear if Applicant intended to exclude the "or more" portion of the "one or more previously-captured images". Clarification of this issue via clearer claim wording is requested. Claims 39-41 and 43 are also rejected due to their dependency from claims 38 and 42.

Claim Rejections – 35 USC §102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 36, 37, and 44 are rejected under 35 U.S.C. 102(e) as being anticipated by Kamentsky et al. (US 5,793,969). This rejection is maintained and reiterated for reasons of record for claims 36 and 37 and necessitated by amendment for claim 44.

Kamentsky et al. disclose a method for network reviewing of a specimen slide (col. 2, lines 54-55). Kamentsky et al. disclose a system for review and analysis of computer encoded microscope slides and specimens originally encoded from a microscope that is retrievable at all remote locations of a network and for comparing an original slide being examined (=real) or scanned image of slide that is stored (=virtual) with on-line library cell type images (=virtual) (abstract) and multiple images at different focuses and magnifications are stored and indexed (claim 15) which represents viewing a microscope slide on a screen and providing a microscope slide and one or more previously-captured images of the slide with each image being a representation of the slide at a magnification. Kamentsky et al. disclose multiple simultaneous reviews of encoded information obtained from slide analysis procedures of a microscope slide including stored images of the slide (col. 2, lines 11-16). Kamentsky et al. disclose the user can

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indicate the microscope objective used by clicking one of the buttons on the panel and store multiple images in the computer memory at different focuses and magnifications (col. 8, last paragraph; Figures 2 and 3) which represents enabling selection of a desired objective for viewing a slide. Kamentsky et al. disclose selecting a patient accession number which causes all of the images of the slide view to be transferred for instantaneous viewing, following by the user selecting a magnification using buttons in the field and a focus to call up and display the appropriate image (col. 9, second paragraph; Figure 3) which represents selecting a desired magnification/objective and determining if it corresponds to the magnification of one of the previously-captured images, wherein if it does correspond, then the previously-captured image is displayed. Kamensky et al. disclose slide diagnosis is either directly with the original slide on the microscope or with a scanned image (abstract) and the user can indicate microscope objective and magnification (col. 8, last paragraph and Figures 2 and 3) wherein actual imaging of the original slide by the user represents obtaining a real-time image at a desired magnification and presenting it on the screen. Kamentsky et al. disclose review of each image captured is repeated for each annotation by clicking the next field button (col. 8, last paragraph and Figure 2) and retrieving images (col. 7, last paragraph). Kamentsky et al. disclose using grayscale display information with variations in shades of gray and degrees of overlap (claim 4) and viewing slides or images of slides only at areas of interest (claim 13) which represents multiple compression levels (i.e. variations in reduced quantity or volume of grayness), as stated in instant claim 37.

Kamentsky et al. disclose determining whether there was overlapping of viewing (col. 1, lines 31-33). Kamentsky et al. disclose providing automatic location and review of flagged slide specimen view sites (col. 2, lines 30-32). Kamentsky et al. disclose moving the slide stage with

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a specimen slide that is operatively linked to computer means to correlate movement and record locations pursuant to automatic programmed instructions (col. 2, line 61 to col. 3, line 13).

Kamentsky et al. disclose network reviewing of a specimen slide that was previously examined with computer encoded movement including correlated recorded markings with areas of interest that are recalled in a computer generated image of the slide (col. 3, lines 24-67) and then placing the specimen slide on the moveable slide stage and moving the stage in correlation with viewing areas with indicia markings on the computer generated image (col. 4, lines 1-14) which represents automatic and sequential shifting regions. Kamentsky et al. disclose marking areas of interest (col. 1, lines 57-65) and moving the stage containing the slide specimen to areas with correlated indicia of the computer generated image having a distinguished marking in order to be directly viewed with the microscope (col. 4, lines 9-14 and col. 9, lines 62-63) which represents shifting and overlapping (correlated) regions to obtain an optimal (desirable) image. Kamentsky et al. disclose relocating slide images at designated sites via a motor driven microscope with computer control (col. 5, lines 35-37 and col. 10, lines 6-10) which represents automatic and sequential shifting of images.

Thus, Kamentsky et al. anticipate claims 36, 37, and 44.

Applicant argues that Kamentsky et al. do not teach the "enabling" and "determination" and "wherein" limitations of instant claims 36 and 44. This statement is found unpersuasive as Kamentsky et al. disclose these limitations, as discussed in detail above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 36-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kamentsky et al. (US 5,793,969) in view of Silverbrook (US 5,329,616). This rejection is maintained and reiterated for reasons of record for claims 36-43 and necessitated by amendment for claim 44.

Kamentsky et al. describe the limitations of instant claims 36, 37, and 44 as described in the 35 USC 102 rejection above. Kamentsky et al. describe transmitting a region of interest to a user (Kamensky et al.: col. 9, second paragraph and last paragraph), as stated in instant claims 39, 41, and 43. Kamentsky et al. do not describe compressing an image, selecting and decompressing a portion of the image (claim 38), recompressing the region of interest (claim 40), and image comprised of a plurality of compressed images and creating a region of interest including selecting and decompressing a portion of one or more compressed images (claim 42).

Silverbrook describes compressing a virtual image, selecting and decompressing a portion of the image (abstract; col. 3, paragraph 6; claim 1), recompressing the region of interest (col. 6, paragraph 4), and image comprised of a plurality of compressed images and creating a region of interest including selecting and decompressing a portion of one or more compressed images (abstract; col. 3, paragraph 6; col. 2, line 50 to col. 3, line 68; claims 1, 14-15).

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to compress and decompress the image as taught by Silverbrook in the method of Kamentsky et al. where the motivation would have been to alleviate the need for large image stores and therefore avoid the problems of cost and time since full color graphic images require massive amounts of data, as stated by Silverbrook (col. 1, lines 9-20 and col. 2, third paragraph).

Thus, Kamentsky et al. in view of Silverbrook make obvious the instant invention.

Applicant argues that Kamentsky et al. and Silverbrook fail to teach the "enabling" and "determination" and "wherein" limitations of instant claim 36. This statement is found unpersuasive as Kamentsky et al. disclose these limitations, as discussed in detail above.

Conclusion

No claim is allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR §1.6(d)). The Central Fax Center number for official correspondence is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. If you have questions on access to the Private PAIR system, please contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, please call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Smith, whose telephone number is (571) 272-0721. The examiner can normally be reached Monday through Thursday from 8 A.M. to 6:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marjorie Moran, can be reached on (571) 272-0720.

August 27, 2008

/Carolyn Smith/
Primary Examiner
AU 1631